

REMARKS

Reconsideration and removal of the final rejections of the claims of the present application are requested in view of the remarks that follow and the showing of the accompanying declaration under 37 C.F.R. § 1.132 of Koichi DAN.

Claims 1, 8 and 13-18 are rejected in the Final Action under 35 U.S.C. 103(a) as being unpatentable over Aoyama et al., U.S. Patent No. 6,365,659 ("Aoyama") in view of Naylor et al., WO 97/47675 ("Naylor") and Kato et al., U.S. Patent No. 6,680,353 ("Kato"). Claim 19 is rejected in the Final Action under 35 U.S.C. 103(a) as being unpatentable over Aoyama in view of Naylor and Kato as applied to claims 1, 8 and 13-18 and further in view of Uchida et al., U.S. Patent No. 6,670,030 ("Uchida").

These rejections are not proper because, first, the Office has not shown that Aoyama, alone or as modified by Naylor and Kato as proposed in the Final Action, discloses a polyester resin composition which meets all of the limitations of the rejected claims. Specifically, the Office has not shown that Aoyama, alone or modified by Naylor and Kato as proposed by the Office, discloses a composition that does not contain titanium-containing particles having an equivalent circular diameter of 1 μ m or more or contains less than 100 titanium-containing particles per 0.02 mg of the composition having an equivalent circular diameter of 1 μ m or more.

In the response filed September 4, 2008, to the first Action dated June 4, 2007, in this application, applicants submitted a table, Table 1, with the response which included data of the number density, i.e., the number of particles per 0.02 mg of composition, of titanium-containing particles, the equivalent circular diameter of which is 1 μm or more, of each of the polyester resin compositions produced in Examples 1, 4-11, 13 and 14 of Aoyama. The number density was measured according to the measuring method used in the examples of the present application (see page 62, line 11, to page 64, line 16). The data showed that none of the compositions of the examples of Aoyama meet the limitation that the number of titanium-containing particles having an equivalent circular diameter of 1 μm or more is less than 100/0.02 mg of the composition, as required by the claims of the present application. Each of the compositions of Aoyama contains more than 300 titanium-containing particles, the equivalent circular diameter of which is 1 μm or more, per 0.02 mg of the composition.

The data of Table 1 were not given weight by the Office because the data were not submitted in declaration form. Applicants are submitting with the present response the data of Table 1 in the form of a declaration under 37 C.F.R. § 1.132 of Koichi DAN.

Referring to Table 1 in the declaration, the heading "Average particle size" under the heading "Particles (X)" is the average particle size of particles added as a lubricant, such as titanium dioxide or silicon oxide. Both Compound oxide (A) as a catalyst and the particles added as a lubricant in Aoyama are included under "Number of particles" under the heading "Polyester resin properties" in Table 1. Table 1 shows that the number of particles having an equivalent circular diameter of 1 μ m or more per 0.02 mg of the composition, including particles of both Compound oxide (A) and Particle (X), is more than 300.

The second column from the right side in Table 1 shows the number of particles of Compound oxide (A) alone having an equivalent circular diameter of 1 μ m or more per 0.02 mg of the composition. The "Particles (X)" are not included here. Table 1 shows that the number of particles of Compound oxide (A) is also more the 300 per 0.02 mg of the composition.

Since the compositions of Aoyama do not meet the limitation of the rejected claims concerning the number of titanium-containing particles having an equivalent circular diameter of 1 μ m or more being less than 100/0.02 mg of the composition, the Office must show that it would have been obvious to a person of ordinary skill in the art to modify Aoyama so as to produce a composition containing less than 100/0.02 mg of the composition of titanium-

containing particles having an equivalent circular diameter of 1 μ m or more. The Office has not shown where a suggestion, teaching or motive to so modify the composition of Aoyama exists in or is supported by the prior art and has not otherwise provided articulated reasoning with some rational underpinning to support a legal conclusion of obviousness (*In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006); see also *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385, at 1396 (quoting Federal Circuit statement with approval)) of modifying the composition of Aoyama to produce a composition containing less than 100/0.02 mg of the composition of titanium-containing particles having an equivalent circular diameter of 1 μ m or more.

For these reasons, the 35 U.S.C. § 103(a) rejection of claims 1, 8 and 13-18 and the 35 U.S.C. § 103(a) rejection of claim 19, which depends on claim 18, are not proper and should be removed.

Second, the comparative data in the present application show that less than 100/0.02 mg of the polyester resin composition composition of titanium-containing particles having an equivalent circular diameter of 1 μ m or more is material to obtaining a composition having good castability and a reduced number of dropouts. (See Comparative Examples 1 and 4 in Tables 1-1 and 1-2). These data demonstrate criticalness for the number density of titanium-containing particles having an equivalent circular

diameter of 1 μ m or more as recited in the claims and rebut any prima facie obviousness alleged by the Office to be supported by the combination of Aoyama, Naylor and Kato. For this reason also removal of the 35 U.S.C. § 103(a) rejections of the claims is in order and is respectfully requested.

Third, in the invention of the present application, ethyl diethylphosphonoacetate has an unexpected effect of decreasing irregular particles. Referring to Examples 1, 6 and 7 of the present application, the number of particles having an equivalent circular diameter of 1 μ m or more per unit weight in Example 1 where ethyl diethylphosphonoacetate was used is far smaller than those recorded in Examples 6 and 7 where other phosphorus compounds specified by Kato were used. As can be seen from these examples, the invention of the present application is based on the finding unknown hitherto that ethyl diethylphosphonoacetate is excellent in inhibiting irregular particles. Such result could not have been reasonably expected from the prior art and, particularly, the proposed combination of Aoyama, Naylor and Kato. These data also rebut any prima facie obviousness alleged by the Office to be supported by the combination of Aoyama, Naylor and Kato.

For this additional reason, removal of the 35 U.S.C. § 103(a) rejections of the claims is in order and is respectfully requested.

PATENT APPLN. NO. 10/529,847
RESPONSE UNDER 37 C.F.R. § 1.116

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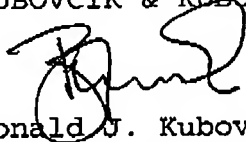
The foregoing is believed to be a complete and proper response to the Office Action dated August 11, 2008, and is believed to place this application in condition for allowance. If, however, minor issues remain that can be resolved by means of a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number indicated below.

In the event that this paper is not considered to be timely filed, applicants hereby petition for an appropriate extension of time. The fee for any such extension may be charged to Deposit Account No. 111833.

In the event any additional fees are required, please also charge Deposit Account No. 111833.

Respectfully submitted,

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Attachment: Declaration under 37 C.F.R. § 1.132 of Koichi DAN